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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.		
10/520,057	12/29/2004	Camilla Maffei	71654	9852		
23872	7590	03/17/2009	EXAMINER			
MCGLEW & TUTTLE, PC P.O. BOX 9227 SCARBOROUGH STATION SCARBOROUGH, NY 10510-9227				PARADISO, JOHN ROGER		
ART UNIT		PAPER NUMBER				
3721						
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03/17/2009		PAPER				

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/520,057	MAFFEI, CAMILLA
	<b>Examiner</b>	<b>Art Unit</b>
	John Paradiso	3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 06 June 2008.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-3 and 5-11 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-3 and 5-11 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-3 and 5-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over DE 8618368 in view of KALMAN (US 3579947), as set forth in paragraph 4 of the previous Office Action and reprinted below for convenience:

DE 8618368 discloses a box and method for forming a box including providing four faces opposing faces (2, 3, 4, 5) (see Fig. 1) and cutting an opening (7) in one of the faces. An appendage (11) is secured to the walls to form two compartments in the box. A cover (1) folds over and into one compartment, forming an appendage therein. A sheet is placed within and covering the opening in space (94).

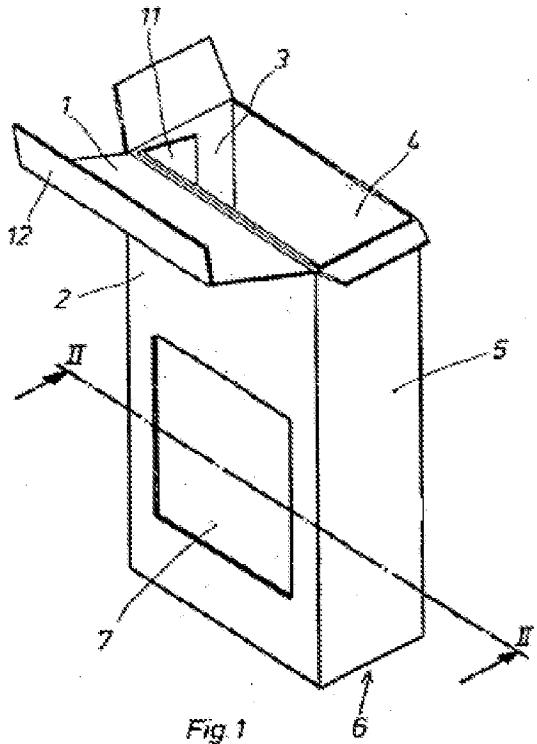
DE 8618368 does not disclose the sheet being folded and glued within a compartment of the box.

KALMAN discloses the folding and gluing of a sheet (28) within an outside enclosure (B) (see column 2:50-75 and Fig. 5).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of DE 8618368 by folding and gluing the insert, as taught by KALMAN, in order to provide a larger insert in a similarly small and secure space.

***Response to Arguments***

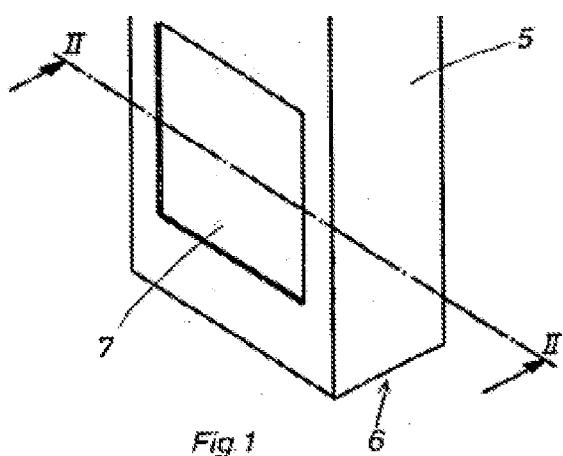
3. Applicant's arguments filed 6/6/2008 have been fully considered but they are not persuasive.
4. Applicant states on page 7 of his Response that "DE '368 fails to teach and fails to suggest the combination of an appendage glued to one of two sides to form a first compartment and a second compartment wherein the first compartment does not have a closing wall."



However, Fig. 1 of DE 8618368 (shown at left) clearly shows an appendage (11) is secured to the walls to form two compartments in the box. A cover (1) folds over and into one compartment, forming an appendage therein. A sheet is placed within and covering the opening in space (94).

5. Applicant states on page 8 of his Response that "DE '368 also fails to teach or suggest the combination of a box comprising a portion of material that is removed to extract sheet-like contents located within a first compartment. At most, DE '368 discloses a window 7 for viewing the contents of the box. However, DE '368 does not disclose that a portion of material is removed to extract a sheet from the window 7 as claimed. In contrast to DE '368, the box of the present invention has a first compartment and a second compartment. A portion of material can be removed so the sheet-like contents can be extracted through an opening. This advantageously allows a person to determine the contents of the box by merely extracting the sheet contained in the first compartment without having to open the second compartment. DE '368 fails to provide such content determining advantages since DE '368 merely discloses a box having two compartments wherein the contents of the box are determined by looking at the window 7. DE '368 provides absolutely no teaching or suggestion for a box having a portion of material removed to extract a sheet without having to open a second compartment as claimed. As such, the prior art as a whole takes a different approach and fails to direct the person of ordinary skill in the art toward the features of the claimed combination."

However, Fig. 1 of DE 8618368 (shown here in part) clearly shows a section (7) that has



been removed. Examiner maintains that the recitation in claim 7 lines 8-10 that "... said portion of material being removed to extract sheet-like contents located within said first compartment..."

6. Applicant states on page 9 of his Response that “Kalman fails to teach or suggest the combination of an appendage glued to one of two sides to form a first compartment and a second compartment wherein the first compartment does not have a closing wall. At most, Kalman discloses a method for printing and folding a mailing piece. However, Kalman is void of any mention of a first compartment that can be accessed without opening the closing wall of a second compartment as claimed. In fact, the references as a whole do not provide any suggestion of using the teachings of Kalman to modify the box of DE '368.”

However, KALMAN is not used to teach “a first compartment that can be accessed without opening the closing wall of a second compartment as claimed”, which is not necessary in any case because DE 8618368 clearly teaches this feature. KALMAN is used to teach the sheet being folded and glued within a compartment of the box (see column 2:50-75 and Fig. 5).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, providing literature in the form of a sheet being folded within an enclosure.

7. Applicant states on page 9 of his Response that “It is not possible to glue the card 9 in the box of DE '368 because DE '368 clearly teaches that the cardboard box must be assembled first and then the card 9 is introduced therein at the time of packaging the product selected by the user. The purpose of DE '368 is to customize a box with a card 9 which must be entirely visible for the user. Kalman does not provide any suggestion that the cardboard 9 of DE '368 can be replaced by a folded sheet as featured in the present invention. Compared with the present invention, the first compartment is devoid of a closing wall and comprises an aperture for inserting and extracting one or more information sheets independently of opening or closing the second compartment.”

However, the argument is irrelevant, since the order of the method steps is not distinctly specified and can be performed in any order. Further, the argument that the “cardboard” of DE 8618368 is not analogous to the folded sheet of KALMAN is misleading: they may be made of thicker or thinner materials, but they are both designed to provide information that can be accessed about a product, in the case of DE 8618368, through the window (7) of the forward compartment.

8. Applicant states on page 10 of his Response that "This is particularly useful in the pharmaceutical field since the doctor can remove the information sheet, read the instructions and see whether the medicine is appropriate for a particular use. If the medicine is incorrect, the doctor can reintroduce the sheet in the compartment and the box can be used by another person since the box has not been tampered with due to the second compartment not being opened. The prior art as a whole fails to provide such tampering preventing advantages since Kalman and DE '368 are absolutely void of any teaching or suggestion of a first compartment that can be opened independently of opening or closing a second compartment. As such, the prior art as a whole takes a different approach and fails to teach or suggest each feature of the claimed combination. Accordingly, Applicant respectfully requests that the Examiner favorably consider claims 1, 7 and 11 as now presented and all claims that respectively depend thereon."

However, while Examiner understands the intentions Applicant has explained, they are immaterial to the rejection, since they relate to the intended use of the invention, rather than the box itself or the method of creating the box, as claimed.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Paradiso. The examiner can normally be reached Monday-Friday, 9:30 p.m. – 6:00 p.m. (ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, can be reached at the number listed below.

Any inquiry of a general nature or relating to the status of this application should be directed to the 3700 Technology Center Receptionist.

/John Paradiso/

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Examiner John Paradiso: (571) 272-4466

March 12, 2009

/Rinaldi I Rada/  
Supervisory Patent Examiner, Art Unit 3721

Additional Phone Numbers:  
Supervisor Rinaldi Rada: (571) 272-4467  
Fax (Official): (571) 273-8300  
Fax (Direct to Examiner) (571) 273-4466 (Drafts only)